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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,692	02/19/2004	David S. Benco	LUTZ 2 00263	4641

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EXAMINER

APPIAH, CHARLES NANA

ART UNIT PAPER NUMBER

2686

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/782,692

Applicant(s)

BENCO ET AL

Examiner

Charles N. Appiah

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/19/04, 8/10/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statements (IDS) submitted on 19 February 2004 and 10 August 2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8, 10-12, 14-16, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by **Alperovich et al. (6,101,393)**.

Regarding claims 1 and 14, Alperovich discloses a method and system for filtering an SMS message sent from an originating terminal to a subscriber terminal in a wireless communications network comprising: providing subscriber-provided authorization criteria screening mechanism having screening application for determining the MSISDN number (or other origin identifier) of an attempting to locate a particular mobile subscriber, see col. 1, line 60 to col. 2, line 2), determining authorization of the originating terminal for sending the SMS message to the subscriber terminal using the authorization criteria (screening application comparing the unique identifier to one of the two lists stored in the HLR, see col. 2, lines 3-11, col. 5, lines 4-21), and filtering the SMS message to the subscriber based on the determining step (screening mechanism

determining whether the incoming message is to be accepted, or alternately not rejected, leading to the message being delivered, or not being delivered, see col. 2, lines 11-22).

Regarding claim 2, Alperovich further discloses wherein the determining step comprises determining the originating terminal is not authorized for sending an SMS message to the subscriber terminal (delivery being rejected when it is determined that origin identifier is not on the list, see col. 5, lines 38-47).

Regarding claim 3, Alperovich further discloses wherein the filtering step includes blocking the SMS message thereby preventing delivery of the SMS to the subscriber terminal (delivery not being permitted, if origination MSISDN is on the rejection list, see col. 5, lines 45-50).

Regarding claim 4, Alperovich further discloses sending a denial message to the originating terminal indicating the SMS message was not delivered to the subscriber terminal (appropriate message being generated and returned to the originating MS, e.g., rejection signal, when delivery is not permitted based on message screening, see col. 5, lines 46-50).

Regarding claim 5, Alperovich further discloses wherein the denial message is an SMS message (feature of message rejection signal 180, Fig. 3).

Regarding claims 6, 7 and 16, Alperovich further discloses wherein the determining step comprises determining the originating terminal is authorized for sending an SMS message to the subscriber terminal (origin identifier being present in acceptance list, see col. 5, lines 22-36), wherein the filtering step includes delivering the

SMS message to the subscriber terminal (SMS message being delivered in the usual manner when the origin identifier is on the acceptance list, see col. 5, lines 36-38).

Regarding claim 8, Alperovich further discloses wherein the subscriber-provisioned authorization criteria includes terminal identifiers (MSISDN), and the determining step further comprises comparing a terminal identifier identifying the originating terminal with the subscriber-provided authorization criteria (see steps 510-538, Fig. 5).

Regarding claim 10, Alperovich further discloses wherein the providing step further comprises: providing the subscriber-provided authorization criteria via a mobile terminal (inherent feature of subscriber profile being stored in HLR with regard to the two screening lists, see col. 2, lines 3-15).

Regarding claim 11, Alperovich further discloses wherein the authorization criteria are a terminal identifier (two lists containing all MSISDN numbers from which SMS messages are to be accepted or not, see col. 2, lines 3-8).

Regarding claim 12, Alperovich further discloses wherein the terminal identifier is a phone number (MSISDN number (or other origin identifier), see col. 1, lines 65-67).

Regarding claim 15, Alperovich further discloses wherein the means for determining authorization comprises a Home location Register (HLR containing the screening mechanism, see col. 5, lines 4-11).

Regarding claim 17, Alperovich further discloses wherein the means for filtering comprises means for blocking delivery of the SMS message to the subscriber

when the originating terminal is not authorized to send SMS messages to the subscriber terminal (delivery not being permitted, if origination MSISDN is on the rejection list, see col. 5, lines 45-50).

Regarding claim 18, Alperovich further comprising means for sending a denial message to the originating terminal indicating the SMS message was not delivered to the subscriber when the originating terminal is not authorized to send SMS messages to the subscriber terminal (appropriate message being generated and returned to the originating MS, e.g., rejection signal, when delivery is not permitted based on message screening, see col. 5, lines 46-50).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alperovich et al** as applied to claims 1 and 11 above, and further in view of **Allison et al. (6,819,932)**.

Regarding claims 9 and 13 Alperovich further discloses wherein the origin identifier is a datum that uniquely identifies the MS or other entity originating the SMS message (see col. 3, lines 31-36), and that the origin identifiers listed on the lists could be something other than MSISDN or IMSI numbers associated with a single originating entity (see col. 6, lines 7-20), but fails to specifically teach that the subscriber-provided

authorization criteria is provided via the Internet and the terminal identifier is an IP address.

In an analogous filed of endeavor, Allison discloses a system and method for preventing delivery of unwanted short message service (SMS) messages wherein a short message discrimination module contains data that include a sending party's identifier that is an IP address (see "spam@aol.com", in Table 1, col. 8, line 45 to col. 9, line 44).

It would therefore have been obvious to one of ordinary skill in the art to combine Allison's unwanted message delivery system with Alperovich's system in order to provide the option of including an IP address as one of the identifiers for making message transmission decisions as taught by Allison.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kim et al. (2005,0020289) discloses a method for blocking SPAM messages in a mobile communication terminal.

Zabawskyj et al. (US 2005/0101306) discloses a system for preventing unwanted wireless communications.

Cai (US 2005/0186974) discloses a method for screening SMS and/or multimedia message service calls.

Kelkar et al. (US2005/0130629) discloses a message management system in wireless communications devices.


Ehrlich (US 2004/0064734) discloses an electronic message processing system having message classification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**